



PATENT
27866/34810

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Gray, *et al.*

Serial No: 09/509,165

Internat'l Filing Date: September 28, 1998

National Stage §371(c): June 12, 2000

For: "Macrophage Derived Chemokine
(MDC), MDC Analogs, MDC
Inhibitor Substances, and Uses
Thereof"

Group Art Unit: 1648

Examiner: Li, Bao Q.

) I hereby certify that this paper is being
) deposited with the United States Postal Service
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) Commissioner for Patents, P.O. Box 1450,
) Alexandria, VA 22313-1450 on October 27,
) 2003.



Kurt T. Buechle

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**REQUEST AND PETITION FOR WITHDRAWAL OF
FINALITY OF OFFICE ACTION MAILED AUGUST 27, 2003**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
ATTN: Examiner Bao Q. Li

Sir:

The applicants respectfully request withdrawal of finality of the Office action mailed August 27, 2003, pursuant to MPEP § 706.07(c) and MPEP §§ 1002.02(c) and 1004 in the above-identified application. If a petition is required in this case, please consider this request as a petition under 37 CFR 1.181. No fees are believed due with this request. Nevertheless, the Commissioner is hereby authorized to charge any fees due with this request (or petition) to Deposit Account No. 13-2855. A response to the August 27, 2003 Office action is being filed concurrently with this request and petition (but addressed to Box AF).

I. STATEMENT OF THE FACTS

Applicants elected claims 26, 30, and 31 (Group VII) with traverse in response to a restriction requirement mailed May 17, 2002, in which the Office alleged that the claims

as filed were directed to twelve distinct inventions. In an action mailed December 3, 2002, the Office maintained the restriction and rejected the elected claims 26, 30 and 31 on various grounds, and additionally presented objections relating to priority and the previously submitted Information Disclosure Statement. In a final action mailed August 27, 2003, the Office rejected claims 26, 30, 31, 38 and 39 on various grounds, and withdrew claims 40-43 for allegedly being directed to a non-elected invention, claims 1-14, 27-29, and 32-37 having been earlier withdrawn.

In applicants' September 17, 2002 response to the restriction requirement of May 17, 2002, applicants elected (with traverse) Group VII claims drawn to a method of palliating an allergic reaction in a mammalian subject using "an MDC antagonist compound or TARC antagonist compound." The May 2002 restriction requirement specified that species restrictions would only be required in the event that applicants elected Group I, II or IV. No such restriction was made for group VII. At the time restriction was made, there were a total of thirty-seven claims (1-37) pending. Group VII included claims 26, 30 and 31. *Since* that time, the claims have been amended and additional claims have been added. However, at the time of the restriction, claim 26 was directed to the use of an MDC antagonist compound or a TARC antagonist compound. Moreover, at the time of restriction, claim 30 was directed, in part, to a "polypeptide fragment or analog of a vertebrate MDC."

In the August 27, 2003 Office Action, the Office alleged that claims 40-43 were "directed to an invention that is independent or distinct from the invention originally claimed." No explanation was provided as to why claims 40-43 were believed to be independent or distinct. The examiner requested that a response include the cancellation of non-elected claims. However, as explained herein, applicants believe that claims 40-43 are within the scope of the elected claims.

II. ARGUMENT

The August 2003 action should not be a final action, because it did not consider claims that are directed to the same invention as elected. And even if the Office maintains its position that claims 40-43 are directed to a non-elected invention, finality should still be removed, the further restriction requirement defined, and applicants be provided an opportunity to further elect.

As to claims 40 and 41, they are directed to MDC antagonists that may be used to palliate allergic reactions. On page 7 of the amendment filed June 3, 2003, applicants explained the reasoning behind the amendment to claim 30 and the addition of claims 40 and 41 as follows: "The various specific fragments and analogs disclosed in the present application provide sufficient support for the original 'fragment or analog' language. However, in order to expedite prosecution, claim 30 has been amended so as to omit the phrase '(a) a polypeptide fragment or analog of a vertebrate MDC that inhibits MDC activation.' New claims 40 and 41 define specific antagonists by structure." Because claim 30 is within the elected group, claims 40 and 41 must necessarily also be within the elected group. Accordingly, the withdrawal of claims 40 and 41 was improper, and the applicants request that they now be considered.

As to claims 42 and 43, they are directly analogous to claims 26 and 30. In applicants' September 17, 2002 response to the restriction requirement of May 17, 2002, applicants elected (with traverse) Group VII claims drawn to a method of palliating an allergic reaction in a mammalian subject using "an MDC antagonist compound or TARC antagonist compound." Before the amendment filed June 3, 2003, claim 26 was directed to a method of palliating an allergic reaction comprising the use of either "an MDC antagonist compound or *TARC antagonist compound*." (emphasis added; see also Appendix A of the June 3rd amendment) The said amendment split claim 26 into two separate claims: claim 26 (directed to an MDC antagonist compound) and claim 42 (directed to a TARC antagonist compound). Because claim 26 as elected was directed to both MDC antagonist compounds and TARC antagonist compounds, claim 42 must necessarily also be within the elected group. A similar argument applies to claim 43, *i.e.*, because claim 30 is in the elected group, claim 43 must also be. Accordingly, the withdrawal of claims 42 and 43 was improper, and the applicants request that they now be considered.

The subject matter currently claimed in claims 26, 30, 31 and 38-43 is within the scope of the claims originally elected (Group VII). At the time of the restriction requirement, the Office made no indication of any kind of restriction requirement within Group VII, *e.g.*, a species election. If the Office now feels that a species or other restriction is required, the Office should so indicate, remove finality, and allow applicants to make an election and/or traverse the restriction. The Office has provided neither argument nor

evidence that claims 40-43 are patentably distinct or independent from claims 26, 30, 31, 38 and 39. The applicants respectfully request a clear definition and explanation of the restriction(s) made in this application, and why it was made, to help clarify their rights in related applications, *e.g.*, double patenting issues in a divisional application. If the Office does not feel a further restriction is necessary, the applicants respectfully request that claims 40-43 be considered along with claims 26, 30, 31, 38 and 39.

The Office is invited to telephone the undersigned to discuss any remaining issues so as to expedite the progress of this case toward allowance.

Respectfully submitted,

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Dated: October 27, 2003



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